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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,866	09/20/2000	Brian J. Brown	S63.2-9397	1548

490 7590 02/04/2005

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER	
PREBILIC, PAUL B	

ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/666,866	BROWN ET AL.	
	Examiner	Art Unit	
	Paul B. Prebilic	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *23 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-45,57,67,79,80,83,84 and 89-96* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *57,79,80,83,84 and 89* is/are allowed.

6)☒ Claim(s) *36-45,67 and 90-96* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Reopening of Prosecution

An appeal conference was held on January 31, 2005. The conferees were persuaded by the thorough reasoning set forth in the Appeal Brief that the rejections were untenable. However, upon further review of the prior art of record and of an updated search, the Examiner discovered that some of the present claims are unpatentable. The Examiner regrets the delay in discovering that the newly applied prior art documents render the claims unpatentable, but such was partially necessitated by the withdrawal of the rejections of the previous Office action.

Upon review of the appeal brief filed in November 2004, it was noted that the heading "Issues" on page 10 was not in compliance with new Rule 37 CFR 41.37(c). In addition, the headings on pages 2 to 33 of the brief contained incorrect serial numbers and filing dates. On page 32 of the brief, line 13, "3." should have been "III."

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 67 and 90-96 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 9-14 and 16-21 of U.S. Patent No. 6,818,014. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are "anticipated" by the patented claims such that the present claims are read on thereby. For this reason, the present claims are considered to be clearly obvious in view of the patented claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

Claims 36, 39, and 41-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Fischell et al (US 2004/0230294). Fischell anticipates the claim language where the proximal end portions of one band are not longitudinally opposite the distal end portions of an adjacent band such that the claim language of lines 12-14 is fully met; see Figure 6 and paragraphs 22, 25, and 30 of Fischell.

Regarding claim 39, the struts on opposite sides of the longitudinals 4T are parallel along a plane cutting through the stent; see Figure 6 and compare to Figure 7 that has oppositely flexed longitudinal in phantom.

Claims 36-39 and 43-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Lam et al (US 5,725,572). Lam anticipates the claim language where the claims are read on in the same manner as Fischell is interpreted *supra*. In particular, where the proximal end portions of one band are not longitudinally opposite the distal end portions of an adjacent band such that the claim language of lines 12-14 is fully met; Figure 1A. The connecting elements of Lam are construed to be extending from the proximal and distal end regions in middle bands as claimed because some connectors extend to one adjacent band and others extend to another adjacent band.

With regard to claims 37-39 and 43-45, there are two lengths of struts in each band such that the present claim language is read upon by Lam et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischell et al (US 2004/0230294) in view of Sahatjian (US 5,304,121). Fischell meets the claim language as explained *supra* but fails to clearly disclose a self-expanding stent as claimed. However, Sahatjian teaches that it was known to use balloon expandable and self-expanding stent interchangeably within the art; see column 9, line 35 to column 10, line 11. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to use a self-expanding stent in Fischell so that a less complicated delivery and

expansion of the device could be utilized, i.e. one not requiring balloon expansion at the site.

Allowable Subject Matter

Claims 57, 79, 80, 83, 84, and 89 are allowed over the prior art of record.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action unless such applications are stored in image format (i.e. IFW). Generally, those applications filed or amended after July 1, 2003 are image file wrapper (IFW) applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Prebilic whose telephone number is (571) 272-4758. The examiner can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Prebilic
Primary Examiner
Art Unit 3738